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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/869,566

02/19/2002

Audrey Goddard

P 2534-3

4737

9157 7590 10/24/2008  
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EXAMINER

JIANG, DONG

ART UNIT

PAPER NUMBER

1646

MAIL DATE

DELIVERY MODE

10/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/869,566	<b>Applicant(s)</b> GODDARD ET AL.	
	<b>Examiner</b> DONG JIANG	<b>Art Unit</b> 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20,22,26-28 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 20,22,26-28 and 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED OFFICE ACTION**

Applicant's amendment filed on 23 July 2008 is acknowledged and entered. Following the amendment, claim 20 is amended.

Currently, claims 20, 22, 26-28 and 31-36 are pending and under consideration.

#### **Formal Matters:**

##### ***Claims***

Claim 20 is objected to for the following informalities, appropriate correction is required for each item:

The claim recites "said polypeptide binds to *an* IL-18R ECD, but not to *an* IL-1R ECD" (line 3). Since both IL-18R and IL-1R only have one ECD, "the IL-18R ECD" and "the IL-1R ECD" is suggested.

#### **Rejections Over Prior Art:**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20, 22, 26-28 and 32-36 remain rejected under 35 U.S.C. 102(e) as being anticipated by Sims et al., US2003/0091532 A1 (now US patent No. 7,033,783), for the reasons of record set forth in the previous Office Actions mailed on 9/27/04, 6/14/05, 1/11/06, 1/30/07 and 1/24/08.

Applicants argument filed on 23 July 2008 has been fully considered, but is not deemed persuasive for reasons below.

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At page 4 of the response, the applicant argues that Sims does not enable or describe fragments of the claimed sequence that bind to an IL-18R ECD, but not an IL-1R ECD that consist of residues 37-203 of Figure 2 (SEQ ID NO:5). This argument is not persuasive for the reasons of record. Although Sims does not explicitly teach that said polypeptide would bind to an IL-18R ECD, but not an IL-1R ECD, such would be the inherent property of the polypeptide. As addressed previously (Office Action mailed on 1/11/06, for example), Sims's polypeptide fragments encompass the present fragment of residues 37-203 of the present SEQ ID NO:5, with 100% sequence identity, and therefore, the functional properties such as differential binding to IL-18R ECD would be inherent for the Sims's polypeptide because it is the same chemical entity as that of the present invention. In *In re Swinehart and Sfiligoj* ((CCPA), 169 USPQ 226, 1971), the Court held:

“Mere recitation of newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; additionally”, where Patent Office has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may, in fact, be an inherent characteristic of prior art, it possesses authority to require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on.”

In the instant case, Sims's polypeptide meets the structural (the sequence) limitation of the claims, and the polypeptides having the same sequence would inherently have the same functional property regardless whether the prior art explicitly discloses that property.

**Conclusion:**

Claim 31 is allowable.

**Advisory Information:**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/Dong Jiang/, Ph.D.  
Primary Examiner, Art Unit 1646  
10/20/08

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